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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,706	09/01/2000	Gilberto Arnaiz	SIEB012/01US	5924

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EXAMINER

WOOD, WILLIAM H

ART UNIT PAPER NUMBER

2124

DATE MAILED: 09/02/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application N .

09/653,706

Applicant(s)

ARNAIZ ET AL.

Examiner

William H. Wood

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) 1-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 53-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

Claims 53-62 have been examined.

#### ***Priority***

1. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(a)-(d) based upon an application filed in WIPO on 3 March 1999. A claim for priority under 35 U.S.C. 119(a)-(d) cannot be based on said application, since the United States application was filed more than twelve months thereafter.

#### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 21 March 2001 was considered by the examiner.

#### ***Drawings***

3. The drawings submitted 01 September 2000 were approved by the draft person.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 53-54 and 56 are rejected under 35 U.S.C. 102(a) as being anticipated by Cyber Media, Incorporated (EP 0 811 942 A2), herein referred to as Cyber Media.

In regard to claim 53, Cyber Media disclosed the limitations:

- ♦ *A method of distributing and installing software upgrades on a client computer in a client server system (page 2, lines 5-10) comprising:*
  - ♦ *setting minimum and maximum versions of installed software for clients (page 13, lines 7-10; Figures 13a, element 1313);*
  - ♦ *defining contents of software version upgrade kits from the minimum and maximum versions of the installed software (page 12, line 55 to page 13, line 56), the software version upgrade kits comprising files, actions, and an upgrade wizard to upgrade one or more software components from one version to another version (page 6, lines 35-36; page 8, lines 1-3);*
  - ♦ *writing the contents of the software version upgrade kits to a database as a table of contents, said table of contents showing the contents of an upgrade kit and which software components are required by a corresponding upgrade (page 8, lines 5-51);*
  - ♦ *instantiating an application on the client computer (computer inherently instantiates applications);*
  - ♦ *verifying that software components for the currently running program are up-to-date (page 6, lines 6-26);*
  - ♦ *if any software component in the currently running program is not up-to-date, interrogating other installed software on the client to determine the installed versions on the client (page 6, lines 6-26);*
  - ♦ *comparing the table of contents of software version upgrade kits to software installed on the client to determine software version upgrade kits*

*needed to be invoked on the client to effect upgrades from a currently installed software version to a required software version (page 6, lines 10-13);*

- ♦ *building the software upgrade kits from the table of contents (page 6, lines 35-36; page 8, line 46-51; page 9, lines 1-32; information in the database to be installed, which is transferred to the client);*
- ♦ *downloading copies of the software upgrade kits from the server to a client to be upgraded (page 6, lines 35-36);*
- ♦ *creating a backup of local files before applying the upgrade (page 6, lines 49-59);*
- ♦ *invoking an upgrade wizard to upgrade software on the client, said upgrade wizard reading a list of upgrade kit items to be performed for the software version upgrade from a driver file and a list of upgrades to be run and the state of each upgrade from a state file, and performing the upgrades (page 9, lines 1-32); and*
- ♦ *after upgrading the software on the client, restarting the original program that invoked the upgrade (page 5, line 5 to page 6, line 9; page 6, lines 49-59).*

In regard to claim 54, Cyber Media further disclosed the limitation *tracking the progress of an upgrade, rolling back changes when an error occurs, instantiating the backed up local files, and restarting the upgrade from a save point* (page 6, lines 49-59).

In regard to claim 56, Cyber Media demonstrated the limitation *downloading one or more upgrade kits to a client before the client requires the upgrade* (page 14, lines 1-8; user request information to acquire software as soon as it is available, i.e. before it is required).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cyber Media, Incorporated (EP 0 811 942 A2), herein referred to as Cyber Media, in view of Kirouac et al. (USPN 5,155,847).

In regard to claim 55, Cyber Media did not explicitly state the limitation *comprising monitoring the progress of a software upgrade on a client from a server*. Kirouac demonstrated that it was known at the time of invention to monitor progress of a client from a server (column 9, lines 34-63). It would have been obvious to one of ordinary skill in the art at the time of invention to implement Cyber Media's system of updates with verification from a server as found in Kirouac's teaching. This implementation would have been obvious because one of ordinary skill in the art would be motivated to

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prevent errors in transmission and verify results from a central administrative controlled point.

8. Claim 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cyber Media, Incorporated (EP 0 811 942 A2), herein referred to as Cyber Media, in view of Siebel Systems, "Siebel Systems: Siebel announces production shipment of Siebel Enterprise Applications Version 3.0", herein referred to as Siebel Systems.

In regard to claim 57, Cyber Media did not explicitly state the limitation *wherein the software being upgraded is database management software, and the upgrades further include database schema changes*. Siebel Systems demonstrated that it was known at the time of invention to upgrade database schema (page 2, third paragraph from bottom, bold text). It would have been obvious to one of ordinary skill in the art at the time of invention to implement Cyber Media's updating software with database upgrading as found in Siebel Systems' teaching. This implementation would have been obvious because one of ordinary skill in the art would be motivated to provide updates/upgrades and installations to as many products as possible for business purposes.

9. Claims 58, 59 and 61 are rejected under 35 U.S.C. 102(a) as being anticipated by Cyber Media, Incorporated (EP 0 811 942 A2), herein referred to as Cyber Media in further view of Dictionary of Computing herein referred to as Computing.

In regard to claim 58, Cyber Media disclosed the limitations of claim 58 substantially same as for claim 53 above, which is incorporated herein. However, Cyber Media did not teach *docking*. Computing demonstrated that it was known at the time of invention to dock computers (page 149). It would have been obvious to one of ordinary skill in the art at the time of invention to implement Cyber Media's updating system with docking as found in Computing's teaching. This implementation would have been obvious because one of ordinary skill in the art would be motivated to expand the usefulness of the Cyber Media system to as many client computers as possible, including mobile ones requiring docking.

In regard to claims 59 and 61, the limitations correspond to the limitations of claims 54 and 56 and are rejected the same herein.

10. Claim 60 are rejected under 35 U.S.C. 102(a) as being anticipated by Cyber Media, Incorporated (EP 0 811 942 A2), herein referred to as Cyber Media in further view of Dictionary of Computing herein referred to as Computing as applied to claim 58 and in further view of Kirouac et al. (USPN 5,155,847). The limitations correspond to the limitations of claims 55 and are rejected the same herein.

11. Claim 62 are rejected under 35 U.S.C. 102(a) as being anticipated by Cyber Media, Incorporated (EP 0 811 942 A2), herein referred to as Cyber Media in further



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view of Dictionary of Computing herein referred to as Computing as applied to claim 58 and in further view of Siebel Systems, "Siebel Systems: Siebel announces production shipment of Siebel Enterprise Applications Version 3.0", herein referred to as Siebel Systems. The limitations correspond to the limitations of claims 57 and are rejected the same herein.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- ♦ Rowley (USPN 5,999,740) disclosed a manifest file describing details of files/components to be installed from a server to update a client's applications.
- ♦ Fawcett (USPN 5,845,077) disclosed the limitations of taking inventory of a client in order to update applications.

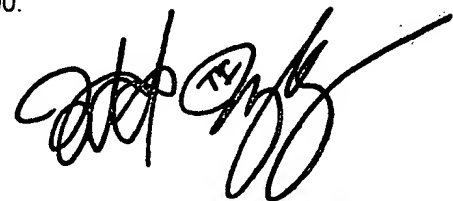
### ***Correspondence Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Wood whose telephone number is (703)305-3305. The examiner can normally be reached 7:30am - 5:00pm Monday thru Thursday and 7:30am - 4:00pm every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (703)305-9662. The fax phone numbers for the organization where this application or proceeding is assigned are (703)746-7239 for regular communications and (703)746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

William H. Wood  
August 22, 2003



**Todd Ingberg**  
**Primary Examiner**  
**Group 2100**